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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,332	03/25/2004	Hidegori Kuwajima	0397-0477PUS1	5433
2292	7590	06/14/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HUYNH, NAM TRUNG	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,332

Applicant(s)

KUWAJIMA, HIDENORI

Examiner

Nam Huynh

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office action has been modified in response to Amendment filed on 3/24/2006. Of claims 1-18; none of the claims have been amended.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohinata et al. (US 2003/0129964) in view of Udom (US 2003/0023882).

A. Regarding claims 1 and 11, Kohinata et al. discloses a cellular phone comprising the following:

- A bio data storage unit (figure 1, item 21) that stores fingerprint data or personal authentication information from at least one or more fingers of the owner of the cellular phone (page 3, paragraph 0044).
- Bio data obtaining units (figure 1, item 19) that obtains fingerprint data or allows a user to input identity information.
- An authentication unit (figure 1, item 20) that compares fingerprint data obtained by the bio data obtaining units with the fingerprint data stored in the bio data storage unit and notifies the result of comparison such as in agreement or not in agreement to the authentication management unit.

Kohinata et al. discloses an authentication management unit for managing the state of the cellular phone and controlling the operation of the cellular phone such as speech and data (packet) communication (page 3, paragraph 0047). However, Kohinata et al. does not explicitly disclose that an informing section transmits an authentication result to the communication base station if personal authentication is failed. Udom discloses a biometric characteristic security system in which a mobile device or "biometric security device" transmits an authenticator to the base station or controller, with a signal representing that an identification of the person has been made (page 3, paragraph 0019). The authenticator uniquely identifies the biometric security device to the controller or base station (page 2, paragraph 0018). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the authentication results to the base station or other security controller, as taught by Udom, using the cellular phone of Kohinata et al. in order to control resource access grants by disabling the ability of certain devices from being used to gain access.

B. Regarding claims 2 and 12, Kohinata et al. discloses the following:

- A bio data storage unit (figure 1, item 21) that stores fingerprint data or personal authentication information from at least one or more fingers of the owner of the cellular phone (page 3, paragraph 0044).
- Bio data obtaining units (figure 1, item 19) that obtains fingerprint data or allows a user to input identity information.
- An authentication unit (figure 1, item 20) that compares fingerprint data obtained by the bio data obtaining units with the fingerprint data stored in the bio data

storage unit and notifies the result of comparison such as in agreement or not in agreement to the authentication management unit.

C. Regarding claims 3 and 13, Udom discloses that a fingerprint, retina, and the audio frequency components of a voice are all biometric characteristics that can be used to identify an individual (page 1, paragraph 0010). Therefore it would be further obvious to one of ordinary skill in the art would recognize that a facial image is a biometric characteristic that identifies a person and could be used for authentication of the "biometric security device".

D. Regarding claims 4, 6, 14, and 16, Udom discloses that authenticators can be stored in memory or electrically programmed into local or onboard memory of the processor of the security device (page 3, paragraph 0019) and that upon the determination that the biometric characteristic (fingerprint, retinal scan, or voice print among others) matches (or at least substantially matches) a stored parameter, the control system computer of the security device might provide access to a controlled area or resource by energizing a lock mechanism or other security device through an appropriate control circuit (page 3, paragraph 0024). Furthermore, the security device transmits an authenticator to the base station or controller, with a signal representing that an identification of the person has been made (page 3, paragraph 0019).

E. Regarding claims 5 and 15, the limitations are rejected as applied to claim 4 and Udom additionally discloses that the characteristics of the scanned fingerprint as compared to those in the database are tested for correspondence and, if no correspondence is found program control might loop back to the fingerprint scanning or

to an error message step which might be used to inform a user that his request for access or authorize was denied (page 3, paragraph 0028). Since the authorization procedure can be looped back and an error message can be displayed to the user, one of ordinary skill in the art would recognize that the authorization procedure is capable of being looped back or repeated a predetermined number of times before an error message is displayed. This would be a design choice.

3. Claims 7-10 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohinata et al. (US 2003/0129964) in view of Udom (US 2003/0023882) as applied to claim 1 above, and further in view of Daudelin et al. (US 6,915,123).

A. Regarding claim 7, the combination of Kohinata et al. and Udom disclose the limitations set forth in claim 1. The combination does not explicitly disclose that the base station stores owner information. Daudelin et al. discloses a method and system for monitoring an operational area of a subscriber station in which the base station (figure 1A, item 10) is connected to a home location register (figure 1A, item 30). The home location register stores subscriber information of the subscriber stations (page 6, lines 58-63). Furthermore, an operational area monitor within the base station of the wireless communications system may report communications activity of particular subscriber stations in their restricted coverage areas as potentially fraudulent activity and the authentication center provides reports to the service provider (column 7, lines 2-10). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the base station characteristics of Daudelin et al.,

Art Unit: 2617

in the communication system of the combination of Kohinata et al. and Udom, in order to store user information and provide reports to the service provider. This added capability allows a service provider to detect if subscriber stations are operating in authorized coverage areas or not (column 1, lines 41-45).

B. Regarding claims 8-10 and 17-18, Daudelin et al. discloses that the home location register also provides an indication of where the subscriber station is active or what base station the subscriber station most recently used (column 6, lines 58-63). The home location register is connected to the authentication center (figure 1A) that provides reports to the service provider or a predetermined organization. Although the home location register and authentication center are not explicitly part of the base station, one of ordinary skill in the art would recognize that these components of the communications system can be interfaced within the base station because they are connected to each other.

Response to Arguments

4. Applicant's arguments filed 3/24/2006 have been fully considered but they are not persuasive.

5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding claim 1, applicant argues that the invention of Udom does not include an identity information inputting section for inputting identity information of a current user of the mobile terminal for identification of an authentic user of the mobile terminal. This argument is not persuasive because Udom does disclose an identity information inputting section for a mobile terminal that is rendered a PDA (a mobile terminal) that comprises a biometric characteristic scanner that can electronically read or "scan" a particular biological (bio) measurable (metric) characteristic (page 1, paragraphs 8,10). Furthermore, this reference was cited to disclose the feature of sending authentication results to a base station and not the limitation presented in the argument because Kohinata et al discloses this limitation.

6. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Art Unit: 2617

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the sending of authentication results, taught by Udom, can result to many advantages which are obvious in the knowledge generally available to one of ordinary skill in the art. Another motivation, in addition to the one stated above in "2A" of this office action which can be found in Udom, paragraph 20, is that a service provider can track the number of times an authentication failure occurs to possibly allow a base station to allocate resources. In the case where a user cannot access his/her mobile device because of failed authentication, a base station does not need to allocate resources for that device since it is not operational. Therefore it may be able to serve the devices that are operational more efficiently.

8. Regarding claim 3, applicant argues that the use of one type of identification information does not make the use of all types of identification information obvious. This argument is not persuasive in that Udom discloses that the biometric characteristic scanner that can electronically read or "scan" a particular biological (bio) measurable (metric) characteristic. Udom further lists examples such as a finger print pattern, retinal pattern, or "voice print" pattern (page 1, paragraph 10). One of ordinary skill in the art would recognize that these biometric characteristics are characteristics that are unique to an individual, and that a facial image is also a unique biological characteristic. Furthermore, Udom discloses that methods to compare a scanned biometric characteristic to a stored or archived characteristic are well known in the art (page 2, paragraph 15).

9. Regarding claim 7, the motivation has been modified in "3A" of this office action to include utilities of the invention of Daudelin et al. and includes citation.

10. Regarding claims 2, 4-6, and 8-18, the original rejections are maintained in view of the responses to arguments stated above, and because no new arguments were raised in the amendment.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam Huynh whose telephone number is 571-272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NTH
6/2/06


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